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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/248,595 02/11/99 FEENEY

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EXAMINER

024492 QM12/0425
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ART UNIT

PAPER NUMBER

3711

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/248,595

Applicant(s)
Brian P. Feeney et al

Examiner
Mitra Aryanpour

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3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Feb 20, 2001

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-6, 8-12, 17, and 18 is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-6, 8-12, 17, and 18 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 16

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 8-12, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friese et al (4,755,187) in view of Walters (5,069,935).

Friese et al shows a method of waterproofing leather by "fatliquoring" agents which produces extremely soft leather and reduces permeability to water. Essentially the process is for the tanning of leather, comprising at least the steps of dyeing and/or tanning, retanning and fatliquoring, the improvement for imparting waterproof properties to the leather.

Friese et al uses the "end product" for shoe upper leather, garment quality suede and heavy suede, however, Friese et al does not specifically indicate applying the method on a leather for a football.

Walters shows a game ball with a tanned leather cover (26) that has moisture resistance properties; a lining (27) made from a sheet (28) of vinyl-impregnated polyester fabric containing

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two or three plies; and an inflatable bladder (34) made of butyl rubber or a synthetic material is known in the art (Column 3, lines 38-52 and Column 4, line 24-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the “fatliquored” method of Frieese et al to the football of Walters in order to provide a waterproofed leather football.

Regarding the preamble recitation that the ball is a “game ball” no patentable weight is given to the term “game ball” because such is a functional term. The leather can be used on any product including a game ball.

Regarding the recitation “wherein when said ball is subjected to three 90 minute cycles of a rain test, such ration being a maximum of 1.25:1.”, such is not given patentable weight because such is a “method of testing” the “end product” under various test conditions in order to determine its durability, i.e. 90 minutes cycles of a rain test, and it is considered to be functional language.

Regarding claim 2, the recitation of “wherein, said ratio is a maximum of 1.15:1”, no patentable weight has been given since the ratio is a result of subjecting the “product” to specific test procedures.

Regarding claims 5 and 6, Walters shows a vinyl-impregnated polyester fabric containing two or three plies. Although applicant has removed the “vinyl” limitation from the claim, still a “polyester” fabric is vinyl-impregnated, and it is well known to use a lining made from the groups consisting of epoxy, polyester and urethane materials.

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Regarding the recitation in claim 3, “wherein when said ball is subjected to six 45 minute cycles of a rain test, at the conclusion of said six rain test cycles being a maximum of 1.19:1.” no patentable weight has been give since it is a “method of testing” the “end product” ” under various test conditions in order to determine its durability, i.e. 45 minute cycles of rain test, and it is considered to be functional language.

Regarding claim 4, the recitation of “wherein, said ratio is a maximum of 1.10:1”, no patentable weight has been given since the ratio is a result of subjecting the “product” to specific test procedures.

Regarding the recitation in claim 8, “wherein when said ball is maximum 90 g of water at the conclusion of said sixth rain test cycle.” no patentable weight has been give since it is a “method of testing” the “end product” ” under various test conditions in order to determine its durability, i.e. six 45 minute cycles of rain test, and it is considered to be functional language.

Regarding claim 9, the recitation of “wherein, said ball will absorb maximum of 65g at the conclusion of said sixth rain test cycle.”, no patentable weight has been given since the ratio is a result of subjecting the “product” to specific test procedures.

Regarding claim 10, the recitation of “wherein, said ball will absorb a maximum per cycle water gain of 115 g water test cycle.”, no patentable weight has been given since the ratio is a result of subjecting the “product” to specific test procedures.

Regarding claim 11, Friese et al shows a method of waterproofing leather by “fatliquoring” agents which produces extremely soft leather and reduces permeability to water. Essentially the

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process is for the tanning of leather, comprising at least the steps of dyeing and or tanning, retanning and fatliquoring, the improvement for imparting waterproof properties to the leather.

Regarding the preamble recitation that the ball is a "game ball" no patentable weight is given to the term "game ball" because such is a functional term. The leather can be used on any product including a game ball such as the one disclosed by Walters.

Regarding claim 12, the recitation of "wherein when maximum of 1.25:1.", no patentable weight has been given since the ratio is a result of subjecting the "product" to specific test procedures.

Regarding claim 17, the recitation of "wherein when maximum of 1.27:1 Conclusion of said first rain test cycle.", no patentable weight has been given since the ratio is a result of subjecting the "product" to specific test procedures.

Regarding claim 18, the recitation of "wherein when maximum of 110 g of water fourth cycle of said rain test.", no patentable weight has been given since the ratio is a result of subjecting the "product" to specific test procedures.

Response to Arguments

3. Applicant's arguments with respect to claims 1-6, 8-12, 17 and 18 have been considered but are moot in view of the new ground(s) of rejection.

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Response to Arguments

4. Applicant's arguments filed 02/20/01 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, combining a method of producing a waterproof leather with a known game ball in order to increase resistance to moisture absorption.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., game ball is placed in a test chamber and an oscillating water spray is disposed over the game ball) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that by subjecting an existing leather to numerous cycles of "rain test", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended

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use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Applicant is claiming a process of making and testing in an apparatus type claim.

In response to applicant's arguments against the references individually, one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant is not claiming the method of testing a game ball by placing a game ball in a test chamber and subjecting the game ball to an oscillating water spray. As pointed out above the claims are not directed to a method of testing a game ball.

With respect to subjecting a game ball to various cycles of tests for various periods of time would be considered obvious, since it would be at the tester's discretion to subject the game ball to however many cycles and for as long as necessary to achieve the results needed for the intended purpose.

With respect to the relevancy of the Walters and Friese et al's references, Walters clearly shows a game ball having a bladder a lining and a cover that has been subjected to various tests to see how well it holds up in real conditions. Friese et al shows a method for producing water proof leather. To use Friese et al's leather to make a game ball as it is shown by Walters and then

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subjecting the game ball to tests similar to the tests taught by either Carlson or Walters would be considered obvious.

Applicant does not indicate in the claims that the game ball can not be pre and post-assembly coated, in any event in "pre-assembly" the tanned leather of Walters is coated which can be considered a part of the tanning process.

If the game ball is superior because of the type of leather used in combination with the bladder and the lining, then applicant should perhaps elaborate on the specifics of the leather, the bladder and the lining and how it is put together to achieve superior results.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is (703) 508-3550. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

MA

April 21, 2001


JEANETTE CHAPMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700